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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

Applicant: David S. HAINING Confirmation No.: 1239
Application Serial No.: 09/838,981
Filed: April 20, 2001
Title: PORTABLE PHOTO SCANNER WITH TASK ASSIGNER

Group Art Unit: 2627
Examiner: Gibbs, Heather D.

Docket No.: 10003829-1

MAIL STOP: APPEAL BRIEF PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Applicant appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed November 2, 2005, finally rejecting Claims 1-16. Applicant filed a Notice of Appeal on December 22, 2005, and Applicant filed an Appeal Brief on February 15, 2006. Applicant respectfully requests that the above-referenced appeal be maintained pursuant to 37 C.F.R. 41.39(b)(2) and submit herewith this Reply Brief to the Office Action mailed May 4, 2006 (hereinafter referred to as the "Examiner's Answer"). Accordingly, no fee is believed due with this Reply Brief.

STATUS OF CLAIMS

Claims 1-16 stand rejected pursuant to the Examiner's Answer mailed May 4, 2006. Claims 1-16 are presented for appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-2, 6-8, 12-14 and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,658,202 issued to Battaglia et al. (hereinafter "*Battaglia*").

2. Claims 3, 9 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of U.S. Patent No. 6,369,908 issued to Frey et al. (hereinafter "*Frey*").

3. Claims 4 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of U.S. Patent No. 5,539,535 issued to Aizawa et al. (hereinafter "*Aizawa*").

4. Claims 5 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of U.S. Patent No. 6,054,707 issued to Hou (hereinafter "*Hou*").

ARGUMENT

A. Standard

1. 35 U.S.C. § 102

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131.

2. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991).

B. Argument

1. First Ground of Rejection (Claims 1-2, 6-8 and 12)

Claims 1, 2, 6-8 and 12 are rejected under 35 U.S.C. §102(e) as being unpatentable in view of *Battaglia*. Of these claims, Claims 1 and 7 are independent. Applicant respectfully submits that each of independent Claims 1 and 7 are patentable

over the *Battaglia* reference and, therefore, Claims 2, 6, 8 and 12 that depend respectively therefrom are also patentable.

Embodiments of the present invention are directed toward a method and device (10, 600) for capturing and/or storing pictures and associating a particular disposition with the pictures such that the disposition can be carried out and/or executed when the pictures are downloaded to a computer (at least at page 5, lines 1-8, page 7, lines 22-29; page 11, lines 19-29; and figures 1-3 and 6). For example, in some embodiments of the present invention, the device (10, 600) comprises user interface indicators such as buttons (12, 13, 602, 700, 703, 704) and/or a touch screen (14, 701, 702) where each indicator is associated with a particular disposition (e.g., e-mail, store to disk, change size, paper print, etc.) (at least at page 5, lines 20-28). In some embodiments of the present invention, meta data is used to indicate a particular disposition for a picture, and particular user interface indicators are associated with particular meta data, thereby correlating the particular indicator with a particular disposition (at least at page 7, lines 22-29). Thus, in some embodiments of the present invention, the user interface indicator, when actuated, would mark and/or tag a particular picture with its associated meta data, thereby associating a particular disposition with the picture (at least at page 7, lines 22-29). Accordingly, Claim 1, for example, recites “an input for receiving a plurality of pictures,” “a storage area for storing the plurality of pictures,” “a plurality of user interface indicators, wherein each indicator is associated with a respective meta data of a plurality of meta data, and each meta data indicates at least one disposition of a plurality of dispositions” and “wherein at least one picture of the plurality of pictures, via activation of an indicator, is associated with a meta data and thereby at least one disposition.”

In the Examiner's Answer, the Examiner asserts that *Battaglia* discloses the limitations of Claim 1 (Examiner's Answer, pages 2 and 3). Applicant respectfully disagrees. *Battaglia* appears to disclose a mass storage device configured to receive a memory module (e.g., a flash memory module removed from a digital camera)

(*Battaglia*, column 2, lines 21-27, figure 1). *Battaglia* also appears to disclose that the mass storage device contains user interface keys 16 and 18 utilized by a user to initiate a download of information from the memory media to the mass storage device or to reformat the memory module (*Battaglia*, column 2, line 66 to column 3, line 5). For example, *Battaglia* recites:

At least one control key is provided for initiating the download operation. Another user interface key is used to reformat the memory module in accordance with its requirements for reuse in, for example, a digital camera for taking further photographs.

(*Battaglia*, column 3, lines 1-5). *Battaglia* further recites:

[T]he user interface keys 16, 18 comprise a portion of a miniaturized keyboard, which may, for example, be utilized to select particular files and directories to copy to the mass storage device 20

(*Battaglia*, column 3, lines 13-17). Thus, *Battaglia* does not appear to disclose or even suggest “a plurality of user interface indicators, wherein each indicator is associated with a respective meta data” where the “meta data indicates at least one disposition” for a picture as recited by Claim 1 (emphasis added). Further, *Battaglia* does not appear to disclose or even suggest “associat[ing] . . . meta data” with “at least one picture . . . via activation of an indicator” as recited by Claim 1. To the contrary, Applicant respectfully submits that pushing a button (e.g., buttons 16 or 18 of the *Battaglia* device) to select particular files is not equivalent to associating meta data with a picture where the meta data indicates the disposition of the picture as generally recited by Claim 1. Accordingly, for at least these reasons, Applicant respectfully submits that *Battaglia* does not anticipate Claim 1.

Further, in the Examiner’s Answer, the Examiner does not explicitly indicate what the Examiner is relying on in *Battaglia* as the “meta data” recited by Claim 1, thereby leaving Applicant to guess as to the Examiner’s reasoning for rejecting Claim 1, which is improper. Applicant respectfully submits that *Battaglia* does not disclose or

even suggest any “meta data” that is associated with any picture or any interface indicator as recited by Claim 1. Moreover, in the Final Office Action mailed November 2, 2005, the Examiner appeared to assert that the particular files and directories that are copied to a mass storage device in *Battaglia* are themselves the “meta data” recited by Claim 1 (“the user interface indicators 16, 18 . . . are associated with particular files and directories (meta data)” (Final Office Action, page 2)). However, the Examiner does not repeat this reasoning in the Examiner’s Answer. If the Examiner maintains the position that the particular files and directories of *Battaglia* that are copied to a mass storage device in *Battaglia* are themselves the “meta data” recited by Claim 1, Applicant respectfully disagrees. *Battaglia* appears to disclose that such “files and directories” correspond to graphical images (*Battaglia*, column 3, lines 13-24). Thus, the Examiner appears to consider such “files and directories” to correspond to both the “pictures” and the “meta data” that is associated with the pictures as recited by Claim 1, which is an improper claim construction. Moreover, such “files and directories” do not appear to indicate any particular disposition, nor has the Examiner identified in *Battaglia* how such “files and directories” of *Battaglia*, themselves, indicate a disposition. To the contrary, Applicant respectfully submits that such teaching is absent from *Battaglia*. Therefore, for at least this reason also, Applicant respectfully submits that *Battaglia* does not anticipate Claim 1.

In the Examiner’s Answer, the Examiner also appears to rely on column 3, lines 25-33 of *Battaglia* as disclosing “a plurality of user interface indicators, wherein each indicator is associated with a respective meta data of a plurality of meta data, and each meta data indicates at least one disposition of a plurality of dispositions” as recited by Claim 1 (Examiner’s Answer, page 2). Applicant respectfully disagrees. *Battaglia* appears to disclose LED display indicators 12 and 14 which may be used in the *Battaglia* device to display a wide range of status indications such as, for example, that a copying operation is complete, that the power is on, or that a download operation is in progress (*Battaglia*, column 3, lines 25-33). Thus, the display indicators 12 and 14 of *Battaglia* relied on by the Examiner appear to be nothing more than an LED that is lit to provide a

user with status information. Accordingly, *Battaglia* does not disclose or even suggest that any “meta data” is associated with the LED indicators 12 and 14 of *Battaglia*. Further, *Battaglia* does not appear to disclose or even suggest that in response to activation of an LED indicator 12 or 14 of *Battaglia*, that any picture is associated with “meta data.” Thus, for at least this reason also, Applicant respectfully submits that *Battaglia* does not anticipate Claim 1.

Independent Claim 7 recites “an input means for receiving a plurality of pictures,” “a storage means for storing the plurality of pictures,” “means for indicating at least one disposition of a plurality of dispositions, the means for indicating associated with a meta data for indicating the at least one disposition” and “wherein at least one picture of the plurality of pictures, via the means for indicating, is associated with said at least one disposition of the plurality of dispositions by associating the meta data with the at least one picture” (emphasis added). At least for the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that *Battaglia* also does not anticipate Claim 7.

Therefore, Claims 1 and 7 are clearly patentable over the *Battaglia* reference. Accordingly, Applicant respectfully submits that Claims 1 and 7, and Claims 2, 6, 8 and 12 that depend respectively therefrom, are allowable.

2. First Ground of Rejection (Claims 13, 14 and 16)

Claims 13, 14 and 16 are rejected under 35 U.S.C. §102(e) as being unpatentable in view of *Battaglia*. Of the rejected claims, Claim 13 is independent. Applicant respectfully submits that independent Claim 13 is patentable over the *Battaglia* reference and, therefore, Claims 14 and 16 that depend therefrom are also patentable.

Independent Claim 13 recites “receiving a plurality of pictures,” “storing the plurality of pictures” and “associating an indication of at least one disposition of a plurality of dispositions with at least one picture of the plurality of pictures, the indication

comprising meta data indicating the at least one disposition” (emphasis added). As discussed above in connection with independent Claim 1, the Examiner also does not explicitly identify in *Battaglia* what the Examiner considers to correspond to the “meta data” recited by Claim 13. In this regard, the Examiner appears to rely only on the Examiner’s discussion of Claim 1 (“Considering claim 1, which is representative of claims 7, 13” (Examiner’s Answer, page 3)), thereby leaving Applicant to guess as to the Examiner’s reasoning for rejecting Claim 13, which is improper. Applicant respectfully submits that *Battaglia* does not disclose or even suggest any “meta data” or that any “meta data” is associated with a picture as recited by Claim 13. In the Final Office Action mailed on November 2, 2005, the Examiner appeared to assert that the interface keys 16 and 18 of *Battaglia* are associated with meta data indicating a disposition of a picture (Final Office Action, page 3). However, the Examiner does not repeat this assertion in the Examiner’s Answer. If the Examiner maintains the position that the interface keys 16 and 18 of *Battaglia* are associated with meta data indicating a disposition of a picture, Applicant respectfully disagrees. Applicant respectfully submits that pushing a button (e.g., buttons 16 or 18 of the *Battaglia* device) to select particular images is not equivalent to associating meta data with a picture where the meta data indicates the disposition of the picture as generally recited by Claim 13.

Moreover, in the Final Office Action mailed November 2, 2005, the Examiner appeared to assert that the particular files and directories that are copied to a mass storage device in *Battaglia* are themselves the “meta data” recited by Claim 13 (“the user interface indicators 16, 18 . . . are associated with particular files and directories (meta data)” (Final Office Action, page 2)). However, the Examiner does not repeat this reasoning in the Examiner’s Answer either. If the Examiner maintains the position that the particular files and directories of *Battaglia* that are copied to a mass storage device in *Battaglia* are themselves the “meta data” recited by Claim 13, Applicant respectfully disagrees. *Battaglia* appears to disclose that such “files and directories” correspond to graphical images (*Battaglia*, column 3, lines 13-24). Thus, the Examiner appears to consider such “files and directories” of *Battaglia* to correspond to both the

“pictures” and the “meta data” that is associated with the pictures as recited by Claim 13, which is an improper claim construction. Additionally, such “files and directories” of *Battaglia* do not appear to indicate any particular disposition, nor has the Examiner identified in *Battaglia* how such “files and directories” of *Battaglia*, themselves, indicate a disposition. To the contrary, Applicant respectfully submits that such teaching is absent from *Battaglia*. Therefore, for at least these reasons, Applicant respectfully submits that *Battaglia* does not anticipate Claim 13.

Therefore, Claim 13 is clearly patentable over the *Battaglia* reference. Accordingly, Applicant respectfully submits that Claim 13, and Claims 14 and 16 that depend therefrom, are allowable.

3. Second Ground of Rejection (Claims 3, 9 and 15)

Claims 3, 9 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of *Frey*. Claims 3, 9 and 15 depend respectively from independent Claim 1, 7 and 13. As discussed above, Claims 1, 7 and 13 are patentable over the *Battaglia* reference. For example, *Battaglia* does not disclose or even suggest associating meta data with a picture where the meta data indicates a disposition of the picture as generally recited by Claims 1, 7 and 13. Moreover, *Frey* does not appear to remedy, nor does the Examiner rely on *Frey* to remedy, at least the above-referenced deficiencies of *Battaglia*. Thus, for at least these reasons, Applicant respectfully submits that Claims 3, 9 and 15 are patentable.

4. Third Ground of Rejection (Claims 4 and 10)

Claims 4 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of *Aizawa*. Claims 4 and 10 depend respectively from independent Claims 1 and 7. As discussed above, Claims 1 and 7 are patentable over the *Battaglia* reference. For example, *Battaglia* does not disclose or even suggest associating meta data with a picture where the meta data indicates a disposition of the picture as generally recited by Claims 1 and 7. Moreover, *Aizawa* does not appear to remedy, nor

does the Examiner rely on *Aizawa* to remedy, at least the above-referenced deficiencies of *Battaglia*. Thus, for at least these reasons, Applicant respectfully submits that Claims 4 and 10 are patentable.

5. Fourth Ground of Rejection (Claims 5 and 11)

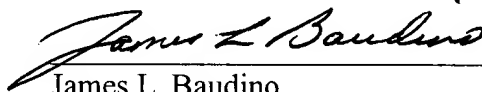
Claims 5 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of *Battaglia* in view of *Hou*. Claims 5 and 11 depend respectively from independent Claims 1 and 7. As discussed above, Claims 1 and 7 are patentable over the *Battaglia* reference. For example, *Battaglia* does not disclose or even suggest associating meta data with a picture where the meta data indicates a disposition of the picture as generally recited by Claims 1 and 7. Moreover, *Hou* does not appear to remedy, nor does the Examiner rely on *Hou* to remedy, at least the above-referenced deficiencies of *Battaglia*. Thus, for at least these reasons, Applicant respectfully submits that Claims 5 and 11 are patentable.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Applicant hereby submits this Reply Brief within two (2) months of the issuance of the Examiner's Answer mailed May 4, 2006. Accordingly, Applicants respectfully submit that this Reply Brief is timely filed pursuant to 37 C.F.R. §§ 41.39 and 41.41 and, therefore, no fee is believed due with this Reply Brief. If, however, Applicant has overlooked the need for any fee, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,


James L. Baudino
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Date: June 21, 2006

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CLAIMS APPENDIX

1. A portable picture storage device comprising:
an input for receiving a plurality of pictures;
a storage area for storing the plurality of pictures; and
a plurality of user interface indicators, wherein each indicator is associated with a respective meta data of a plurality of meta data, and each meta data indicates at least one disposition of a plurality of dispositions;
wherein at least one picture of the plurality of pictures, via activation of an indicator, is associated with a meta data and thereby at least one disposition.
2. The portable picture storage device of claim 1 wherein:
the one picture is associated with the meta data during storage into the device.
3. The portable picture storage device of claim 1 wherein the at least one disposition is selected from the group consisting of:
printing, storing to another storage area, e-mailing to a recipient, image processing, and deleting.
4. The portable picture storage device of claim 1 wherein:
the device is a camera and the input is a lens imaging system.
5. The portable picture storage device of claim 1 wherein:
the device is a scanner and the input is a scanning mechanism.
6. The portable picture storage device of claim 1 wherein:
the device is coupled to a computer system, which receives the one picture, and processes the one picture according to the meta data associated with the one picture.

7. A system for managing disposition of a plurality of pictures, comprising:
an input means for receiving a plurality of pictures;
a storage means for storing the plurality of pictures; and
means for indicating at least one disposition of a plurality of dispositions, the
means for indicating associated with a meta data for indicating the at least one
disposition;

wherein at least one picture of the plurality of pictures, via the means for
indicating, is associated with said at least one disposition of the plurality of dispositions
by associating the meta data with the at least one picture.

8. The system of claim 7 wherein:
the one picture is associated with the at least one disposition during storage into
the device.

9. The system of claim 7 wherein the at least one disposition is selected from the
group consisting of:
printing, storing to another storage area, e-mailing to a recipient, image
processing, and deleting.

10. The system of claim 7 wherein: the system is a camera.

11. The system of claim 7 wherein: the system is a scanner.

12. The system of claim 7 further comprising:
coupling means for connecting the system to a computer, wherein the computer
includes means for receiving the one picture, and means for processing the one picture
according to the at least one disposition associated with the one picture.

13. A method for managing disposition of a plurality of pictures, comprising:
receiving a plurality of pictures;
storing the plurality of pictures; and
associating an indication of at least one disposition of a plurality of dispositions with at least one picture of the plurality of pictures, the indication comprising meta data indicating the at least one disposition.

14. The method of claim 13 wherein:
the step of associating is operative with the step of storing.

15. The method of claim 13 wherein the dispositions are selected from the group consisting of:

printing, storing to another storage area, e-mailing to a recipient, image processing, and deleting.

16. The method of claim 13 further comprising:
connecting the system to a computer;
receiving, by the computer, the one picture;
processing, by the computer, the one picture according to the at least one disposition associated with the one picture.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None

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PATENT APPLICATION

ATTORNEY DOCKET NO. 10003829-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): David S. HAINING

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TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on May 4, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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